

2. RESPONSE/REMARKS

2.1 STATUS OF THE CLAIMS

Claims 33-82 were pending at the time of the Action.

Claims 33-75 are canceled herein, without prejudice and without disclaimer.

Claim 77 is amended herein.

Claims 83-101 are added herein.

Claims 76-101 are presently pending in the case.

2.2 SUPPORT FOR THE CLAIMS

Support for the pending claims can be found throughout the original claims, specification and figures as filed. It will be understood that no new matter is included within any of the newly added, or currently amended claims. Support for new claims 83-101 can be found throughout the Specification and also in withdrawn original claims 34, 35, 75, 43, and 36. In view of the claims canceled to date, no fees are believed to be due for entry of the present amendment; however, should any such fees be due for any reason, the Commissioner is authorized to deduct all necessary amounts from the Deposit Account referenced *supra*.

**2.3 THE REJECTION OF CLAIMS UNDER 35 U. S. C. § 112, 1ST AND 2ND PARAGRAPHS,
IS OVERCOME.**

The Action at page 2 rejects claims 76-82 under 35 U. S. C. § 112, 2nd paragraph, allegedly as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as his invention.

The Action at page 3 also rejects the same claims under 35 U. S. C. § 112, 1st paragraph, allegedly because the specification, while being enabling for a “hydrophobic surface treatment composition consisting of components (a), (b), and (c), does not provide enablement for a hydrophobic surface treatment composition comprising components (a), (b), and (c).”

With respect to both of these rejections, Applicants respectfully traverse.

The single issue remaining in the present application is a question regarding whether or not the Specification supports the use of the “open” transitional language, *comprising*, in the pending claims, in addition to use of the “closed” transitional language, “consisting of,” which the Office has already acknowledged is patentable.

This issue is reflected in the Action by rejections under both Section 112, first paragraph, and Section 112, second paragraph (*i.e.*, enablement and written description).

The Action on page 3 erroneously concludes that because the numerical values of the three compounds that are comprised within the composition of claim 76 “add up to 100%”, the Specification lacks adequate written description for compositions *comprising* the three compounds. Similarly, the Action concludes in Item 6 that the Specification provides enablement only for compositions that *consists of* the three compounds enumerated in the claim in the *exact* recited numerical weight %’s (*i.e.*, 2% polysiloxane + 97.4% solvent + 0.6% catalyst).

Applicants respectfully traverse, and note that the claim does not specify that the three compounds must be present in exactly those precise numerical weight percentages. In fact, the claim *clearly* states that the three recited ingredients may be present in the composition at weight percentages that are “*about* 2%” of polysiloxane, “*about* 97.4% solvent” and “*about* 0.6% of a

catalyst (in this case, acetic acid). The use of the qualifier “about” in each of those compounds *clearly* encompasses embodiments of Applicants’ invention in which the weight %’s of the enumerated compounds are *approximately equal to* the exact recited numerical amounts, but not necessarily *exactly equal to* the precise numerical amounts.

Clearly, a skilled artisan in the field upon a fair reading of the Specification as a whole would both appreciate and understand that the three compounds recited in the composition of claim 76 need not be present in *exactly* the recited amounts, particularly since the ordinary meaning of the term “about” would *de facto* teach the skilled artisan that the claimed compositions need *not comprise* the recited compounds in *exactly* the numerical weight percentages.

Further, if only one the three compounds is present in an amount that is even *slightly* less than its exact numerical recitation, then, by definition, the three compounds would not “add up to 100%”, and thus preclude any additional components of the composition. For example, if the polysiloxane were present in the composition in an amount of 1.92%, the limitation of “about 2%” polysiloxane is still met, yet the three named ingredients of the composition would then not “add up to 100%”, and thus, the composition could contain one or more additional compounds.

Likewise, if the solvent were present in the composition in an amount of 97%, the limitation of “about 97.4%” polysiloxane would still be satisfied, yet the three ingredients under that scenario would not “add up to 100%.”

Paragraph 13 of the Specification teaches that the stated numeric values disclosed in the application represent approximate values, and as such, may vary by a few to as many as several percentage points from the exact numeral. Clearly, the Specification supports and encompasses not only compositions that *consist of* the three compounds mentioned in claim 76, but also

supports and encompasses compositions that consist essentially of those compounds, as well as those compositions that *comprise* the three compounds in claim 76.

Moreover, Paragraph 29 of the Specification clearly also teaches that one or more catalysts may optionally be comprised within the claimed surface treatment compositions. Therefore, the claimed subject matter, *de facto*, cannot be limited only to those compositions that consist solely of a polysiloxane, a solvent, and acetic acid in exactly the numerical weight percentages enumerated in claim 76. There is no suggestion or explicit teaching in the Specification that would cause one of skill in the art to erroneously conclude that the 3 recited compounds need be present in a composition in exactly the ratios such that all three ingredients “add up to 100%” There is simply nothing in the Specification that so limits the scope of the claimed invention, and for that reason, Applicants respectfully request that the rejection be withdrawn.

Applicants further note that Paragraph 30 of the Specification teaches that an optional catalyst may be present in certain formulations of the composition, and that the amount of this optional catalyst “typically ranges from greater than 0 percent by weight, to about 10 percent by weight of the composition.” Thus, the only credible interpretation of the Specification as a whole would be that the claimed compositions substantially comprise the three recited ingredients, and may optionally comprise one or more additional ingredients.

For example, Paragraph 31 of the Specification *clearly* teaches that the claimed surface treatment compositions may also optionally comprise one or more optional ingredients “such as plasticizers, anti-oxidants, light stabilizers, mildewcides and fungicides, surfactants, and flow control additives as are well known in the art.” Again, the *only* credible interpretation of the specification as a whole is that the invention encompasses the optional inclusion of one or more

of these disclosed compounds in the claimed compositions, and as such, the use of the “comprising” transitional is proper claim language, having a definite scope.

Applicants also draw the Examiner’s attention to the various examples presented in the Application that provide ample evidence that the surface treatment compositions taught by the present invention do not solely encompass compositions that “consist of (a) about 2% by weight of a methoxy functionalized polysiloxane having a viscosity of about 20 cps at 25°C; (b) about 97.4% by weight of a solvent; and (c) about 0.6% by weight of acetic acid.”

Example 1, beginning at Paragraph 38, describes a hydrophobic surface treatment composition that “has about 5.0 percent by weight of a polysiloxane..... about 78 percent by weight of ethanol and about 16 percent by weight of isopropyl alcohol,” to which “acetic was added as the catalyst in an amount of about 1.0 percent by weight.” This clearly supports the Applicants’ position that the claimed compositions may comprise a polysiloxane, a solvent, and a catalyst, that does not *exactly* or *singularly* consist of (a) 2% by weight of a methoxy functionalized polysiloxane, (b) 97.4% by weight of a solvent, and (c) 0.6% by weight of a catalyst.

Likewise, Example 2, beginning at Paragraph 40, describes a hydrophobic surface treatment composition that “has about 8.5 percent by weight of a polysiloxane..... about 80 percent by weight of ethylene glycol monobutyl ether and about 11% by weight of hydrocarbon solvent, to which sulfuric was added as the catalyst in an amount of about 0.5 percent by weight.” Again, this example *clearly* supports the Applicants’ position that the claimed compositions may comprise a polysiloxane, a solvent, and a catalyst, and that such a composition need not *exactly* or *singularly* consist of only (a) 2% by weight of a methoxy functionalized polysiloxane, (b) 97.4% by weight of a solvent, and (c) 0.6% by weight of a catalyst.

Turning now to the relevant case law in support of Applicants' position, the M. P. E. P. at §2173.02 summarizes, in pertinent part:

“(T)he test for definiteness under 35 U. S. C. §112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertainthe meaning of the (claim) terms in light of the specification, 35 U. S. C. § 112, second paragraph, is satisfied.”

Applicants contend that the teachings of the Specification, and particularly those cited *supra* meet the test established in *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.* and to that end, believe that one of skill in the art would clearly be able to make and use the claimed compositions in view of the teachings of the Specification. Moreover, Applicants take the position that such a skilled artisan would be able to comprehend the scope of the claimed invention, and would, therefore, also be able to make and use compositions comprising the 3 compounds of claim 76, in a ratio that is approximately equal to the stated weight percentages. As such, Applicants now respectfully request that the rejection be withdrawn.

Secondly, to address whether or not the claimed compositions would be rendered indefinite if, for example, the approximate weight percentages of the three compounds, would theoretically exceeded a content greater than 100%, *In re Kroekel* provides clarity:

“.....a composition claimed to have a theoretical content greater than 100% (i.e., 20-80% of A, 20-80% of B and 1-25% of C) was not indefinite simply because the claims may be read in theory to include compositions that are impossible in fact to formulate. It was observed that subject matter which cannot exist in fact can neither anticipate nor infringe a claim. *In re Kroekel*, 504 F.2d 1143, 183 USPQ 610 (CCPA 1974).”

Similarly, to address the issue of whether or not the claimed compositions would somehow be rendered indefinite if the transitional “comprising” language is employed, *In re Miller* is noted::

“Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.”

Additionally, to address the propriety of using the term “about” to define a clear, but flexible range of weight percentages to formulate the claimed compositions from the three compounds comprised therein, M. P. E. P. §2173.05(b)(A) states in pertinent part:

“The term “about” used to define the area of the lower end of a mold as between 25 to about 45% of the mold entrance was held to be clear, but flexible. *Ex parte Eastwood*, 163 USPQ 316 (Bd. App. 1968). Similarly, in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), the court held that a limitation defining the stretch rate of a plastic as “exceeding about 10% per second” is definite because infringement could clearly be assessed through the use of a stopwatch. However, the court held that claims reciting “at least about” were invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term “about.” *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991).”

The Action at page 3 also rejects the pending claims under 35 U. S. C. § 112, 1st paragraph, allegedly because “it appears that the scope of this embodiment is only enabled with the use of a hydrocarbon solvent (boiling point ~320°F)--not any solvent.”

Again, Applicants respectfully traverse, and note that the invention is not limited to the use of hydrocarbon solvents only, nor is the invention limited to solvents with an exact boiling point of ~320°F). While the particular Example in the Specification to which the Examiner

refers on page 3 of the Action does, in fact, involve the use of a particular hydrocarbon solvent having a particular boiling point, the Specification as a whole in no way teaches that these are the ONLY parameters which can be used in the preparation of the disclosed compositions. In fact, the Specification *clearly* teaches otherwise:

For example, paragraph 23 of the Specification clearly teaches that “(s)uitable solvents include, but are not limited to, alkyl or aryl, substituted or unsubstituted alcohols, ethers, esters, or hydrocarbons having between 1 and 40 carbon atoms. In some embodiments the solvent is water. Other solvents have a boiling point ranging from about 150°F to about 350°F. However, any solvent that is miscible with the employed silicone fluid may be used.”

Paragraph 24 provides clear description of a variety of suitable solvents, including, *inter alia*, ethylene glycol derivatives, toluene, xylene, ethyl acetate, butyl acetate, methyl ethyl ketone, methyl ethyl ketoxime, (mono) propylene glycol tertiary butyl ether, and propoxy propanol.

Similarly Paragraph 25 of the Specification provides clear description of suitable hydrocarbon solvents, including, *e.g.*, mineral spirits and isoparaffin, while Paragraph 28 illustrates exemplary co-solvents which may also be used in the practice of the present invention..

Likewise, the Specification also provides ample evidence that the boiling points of exemplary solvents need not be exactly ~320°F (the boiling point of the solvent exemplified in Example 3). In fact, in Example 2, a hydrocarbon solvent was employed having a boiling of ~260°F, and in Example 4, the hydrocarbon solvent utilized had a boiling point of ~300°F. Thus, it is clear from a fair reading of the Specification as a whole, and considering particular illustrative embodiments in specific, that the boiling point of the particular solvent utilized in

formulation of the claimed compositions need not be restricted to those of ~320°F. In fact, the range of boiling points for suitable solvents can vary widely, depending upon which solvent species is used.

To summarize the relevant points, it is clear that a person skilled in the art upon reading the present Specification and pending claims would understand how to make and use the invention across its claimed breadth. Moreover, the skilled artisan would appreciate that the composition of claim 76 may comprise the recited elements in *approximately* the relative concentrations as enumerated in the claim language; but that the composition need not necessarily be limited to those that consist of, or consist essentially of, the exact numerical value quantities of the three recited compounds.

Likewise, the skilled artisan, upon review of the present Specification, would conclude that the invention is in no way limited to compositions that contain the precise numerical amounts of the three recited compounds, nor is it limited to compositions that consist of, or consist essentially of, the three recited ingredients, in the absence of any other ingredient(s), no matter how small the concentration of the additional ingredient(s) are.

Moreover, it is also clear from a fair reading of the Specification and claims that the particular solvent(s) employed in the practice of the invention need not be restricted to a particular hydrocarbon solvent, nor does the boiling point of exemplary hydrocarbon solvents need be ~320°F nor identical to each other.

For each of these reasons, (a) use of the transitional “comprising” language is both proper and fully supported by the Specification; and (b) the employed solvent need not be limited to a particular hydrocarbon species, nor does it have to be a solvent with a particular boiling point.

Applicants respectfully request, therefore, withdrawal of the pending rejections for all claims.

2.4 EXAMINER INTERVIEW

Applicants acknowledge and appreciate the telephonic interview granted by Examiner Feely with their undersigned representative, and conducted on November 15, 2006. Pending claims 76-82 were discussed in this interview with respect to the outstanding enablement and written description rejections. Likewise, Applicants' representative and Examiner Feely also discussed claim language specific to additional hydrophobic surface treatment compositions. These discussions are exemplified by new claims 83-101, which particularly point out and distinctly claim particular novel, non-obvious, hydrophobic surface treatment compositions useful in the practice of the methods of coating a surface in the present invention.

In view of this very helpful teleconference, Applicants believe that an agreement was reached with respect to all pending claims, and further believe that the present submission renders these claims acceptable under all sections of the Statutes. Applicants appreciate the guidance of Examiner Feely and the helpful suggestions he made in developing the scope of the pending amendments.

Mindful of patent term, and with a view towards achieving a speedy and cost-effective allowance of the pending claims, Applicants now earnestly solicit issuance of a Notice of Allowance in the case with all due speed, and explicitly reserve their right to re-file claims directed to one or more non-elected invention(s) in one or more suitable continuing and/or divisional applications as may be desired during the pendency of the present application.

2.5 CONCLUSION

It is respectfully submitted that all claims are fully enabled by the Specification, and that all claims are definite, and free of any concerns of prior art. Applicants believe that the claims are acceptable under all sections of the Statutes and are now in conditions for ready allowance, and that all of the concerns of Examiner Feely have been resolved. Applicants earnestly solicit concurrence by the Examiner and the issuance of a Notice of Allowance in the case with all due speed.

Should Examiner Feely have any additional questions upon review of the present paper, a telephone call to the Applicants' undersigned representative would be appreciated.

Respectfully submitted,



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